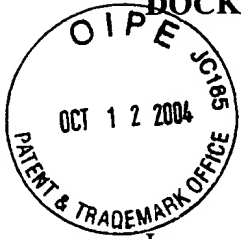


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DOCKET NO.: CIT-0010

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

RECEIVED

OCT 18 2004

Technology Center 2600

In re application of:

**Maki Wakita, Katsutoshi Makaijima and Shoji Takahashi**

Application No.: 09/763,014

Group Art Unit: 2652

Filed: May 29, 2001

Examiner: Allen T. Cao

For: Card-Type Magnetic Recording Device

EXPRESS MAIL LABEL NO: ER 073033115 US  
DATE OF DEPOSIT: October 12, 2004

  
James T. Hagler, Registration No. 40,631

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

**APPEAL BRIEF UNDER 37 C.F.R. § 1.192**

This is a response to a Notice of Non-Compliance with 37 CFR 1.192(c) mailed 9/13/04.

Appellants have amended the concise explanation of the claimed invention to include references to the specification by page and paragraph number and to the drawings.

This is an appeal from the final rejection of claims 13-24 in an Official Action dated May 16, 2003. Appellants filed a Notice of Appeal from the Examiner's final rejection on November 13, 2003.

This appeal brief is being submitted in triplicate, pursuant to 37 C.F.R. § 1.192(a).

**DOCKET NO.: CIT-0010**

**PATENT**

Authorization to charge Deposit Account 50-2733 has been given to cover the fee of \$320.00 for filing an Appeal Brief, as set forth in 37 C.F.R. § 1.17(c).

Appellants respectfully request that the Examiner's final rejection be reversed and that the application be remanded to the examining group for allowance.

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## **A. REAL PARTY IN INTEREST**

The real parties in interest in the present appeal are Citizen Corporation and Iomega Corporation based on Assignments recorded at Reel 012234/0063 and Reel 012242, Frame 0692.

## **B. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences known to the Appellants, the Appellants' legal representative, or the Assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the present appeal.

## **C. STATUS OF CLAIMS**

The status of the claims is as follows: Claims 13-24 stand finally rejected and are now on appeal. Claims 13-24 are reproduced in the Appendix. Presently, no claims are allowed.

The present application was filed on May 29, 2001, claiming priority under 35 U.S.C. § 371 to PCT/JP00/03911 and containing claims 1-12. In an Official Action dated August 21, 2002, the Examiner rejected claims 1-12 under 35 U.S.C. § 101 based on statutory double patenting. A Response thereto was filed in the United States Patent and Trademark Office on February 19, 2003 and claims 1-12 were canceled, claims 13-24 were added and a substitute specification was filed.

In a final Official Action dated May 16, 2003, the Examiner rejected claims 13-24 under 35 U.S.C. § 112 as containing new matter and objected to the specification under 35 U.S.C. § 132 as introducing new matter. On September 16, 2003, A Response to the final Official Action was

filed requesting reconsideration along with a Petition Under 37 C.F.R. § 1.182 to Accept Amendment By A Substitute Specification Pursuant to 37 C.F.R. § 1.121.(b)(3) was filed.

**D. STATUS OF AMENDMENTS**

No amendments have been filed subsequent to the final rejection of claims 13-24 on October 23, 2001.

**E. SUMMARY OF THE INVENTION**

The subject invention provides a card-type magnetic recording device (1), which makes it possible to mount a disk within dimensions that are restricted within narrow limits and permits a head arm (14) to move smoothly between a position for access of the head arm to the disk (spec. page 11, paragraph 0077 through page 12, paragraph 0078) and a position for retreat of the head arm from the disk (Figure 5, spec. page 10, paragraph 0069), and further has the head arm resistant to shocks (spec. page 3, paragraph 0014). The head arm (14), to which a head is mounted, is formed in a flat plate-like shape and adopts a swing arm structure permitting swing motions about an axis of a base part, while a load ramp is arranged at a distance from the peripheral edge of the disk (spec. page 3, paragraph 0015).

**F. ISSUES**

*1. Was the filing of the substitute specification properly objected to under 35 U.S.C. § 132 on the grounds of introducing new matter.*

*2. Are claims 13-24 properly rejected under 35 U.S.C. § 112 as introducing new matter.*

**G. GROUPING OF CLAIMS**

As to the rejection applied against Claims 13-24 under 35 U.S.C. § 112, the rejected claims stand or fall together.

**H. ARGUMENT**

*1. Appellants respectfully traverse the Examiner's objection to the specification under 35 U.S.C. § 132. Appellants traverse and submit that substitution of the specification was proper.*

The substitute specification is a correct English translation of the Japanese International Application PCT/JP00/03911 filed under 35 U.S.C. § 371 in the national phase filing in the U.S. Patent and Trademark Office for the above-identified application. The substitute specification includes no new matter but rather simply clarifies that which was already present in the application by way of the international application.

The substitute specification corrects an error that inadvertently occurred. As stated in the previously submitted Declaration by Naoyuki Horibe, Mr. Horibe inadvertently provided an incorrect English translation of the Japanese International Application PCT/JP00/03911. As stated in the previously submitted Declaration of Valerie Chicchi, Ms. Chicchi inadvertently filed the incorrect English translation under 35 U.S.C. § 371 in the national phase filing in the U.S. Patent and Trademark Office on May 29, 2001. The incorrect English translation is from an unrelated case filed by Applicants at about the same time as the instant case.

Nevertheless, a copy of the *correct* International Application as filed under 35 U.S.C. § 371(c)(2) was transmitted to the United States Patent and Trademark Office by the International Bureau. The error that occurred was merely the filing of an incorrect translation in accordance with MPEP § 1893.01(d). Because the original Japanese version of the PCT application contained the information that the applicant now seeks to introduce through substitutes

specification was in the original PCT version albeit in Japanese, that substitute specification cannot be new matter.

The drawings, i.e., Figures 1 through 8, as originally filed with the U.S. Patent and Trademark Office on May 29, 2001 were and are correct and provide additional support to the notion that no new matter has been introduced. No amendment or substitution is made for Figures 1 through 8.

***2. Appellants respectfully traverse the Examiner's rejection of claims 13-24 under 35 U.S.C. § 112. Appellants traverse and submit that the claims introduce no new matter..***

Regarding the rejection of claims 13-24, the claims are fully supported by the drawings as well as the original Japanese version of the international application. As such, Appellants submit that the rejection of the claims under 35 U.S.C. § 112 was improper for similar reasons to those that apply to the objection to the substitute specification, but with the added provision that the originally filed drawings provide support for the claims.

**I. CONCLUSION**

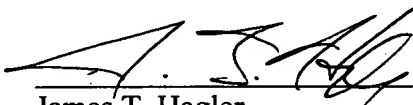
For the reasons presented above, the Examiner has failed to establish a proper basis for the objection of the specification under 35 U.S.C. § 132 and the rejection of the claims under 35 U.S.C. § 112. The Examiner is therefore requested to reconsider and withdraw the Final Rejection, and to allow the application in its present form.

Should the Examiner decline to withdraw the objection under 35 U.S.C. § 132 and the rejection under 35 U.S.C. § 112, the Board is respectfully requested to reverse the Examiner's rejection.

Favorable action with early allowance of all pending claims is earnestly requested.

Respectfully submitted,

Dated: October 11, 2004

  
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APPENDIX

Claims presently in application:

13. A card-type magnetic recording device comprising:  
a head arm which carries a magnetic recording/reproducing head carried;  
a motor for driving to revolve a disk which serves as a recording medium for recording of information;  
a load ramp permitting to place said head on standby after retreat of the head from the surface area of the disk; and  
an information processor:  
wherein said head arm is formed in the shape of a flat plate and adopts a swing arm structure permitting swing motions about an axis in the base part; and  
said load ramp is arranged at a distance from the peripheral edge of the disk.
14. A card-type magnetic recording device according to claim 13, further comprising guide means for guiding the end of said head arm from said load ramp toward the surface area of the disk and also in the reverse direction.
15. A card-type magnetic recording device according to claim 14, wherein said guide means is provided on said head arm.
16. A card-type magnetic recording device according to claim 14, wherein said guide means is composed of a structure provided on the head arm and a structure provided on the side of the load ramp.
17. A card-type magnetic recording device comprising:  
a head arm of swing arm structure, which carries a magnetic recording/reproducing head;  
a motor for revolving a disk serving as a recording medium for recording/reproduction of information;

a load ramp permitting to place said head on standby after retreat of the head from the surface area of the disk;

an information processor; and

a guide arm provided on the head arm at a position at a distance from the end toward the intermediate position in the longitudinal direction in a manner such that it projects toward the side opposite to the disk;

wherein the projection end of said guide arm remains on the load ramp when the end of the head arm, which moves toward the disk, is disengaged from the load ramp, thus maintaining the head arm end at an isolation position where the head does not make contact with the disk within the disk surface area, during the time until the guide arm is disengaged from the load ramp.

18. A card-type magnetic recording device according to claim 17, wherein said load ramp has a support part for supporting the end of the head arm and a rail part for supporting the end of the guide arm, and each of the ends of the support part and the rail part on the side of the disk is formed in the shape of a taper surface of a thickness gradually reduced toward the disk.

19. A card-type magnetic recording device according to claim 18, wherein the surface, which serves as the head arm end, of the support part is inclined toward the base part of the head arm to bring a contact portion of the head arm end with the support part closer to the base part of the head arm.

20. A card-type magnetic recording device according to claim 18, wherein the taper surface in said support part begins at position closer to the disk side than the taper surface of the rail part.

21. A card-type magnetic recording device according to claim 18, wherein the projection end of the guide arm is located closer to the inner side of the head arm than the end of the head arm while maintaining a difference in altitude, and the rail part and the support part are formed to maintain the same difference in altitude as the above difference.

22. A card-type magnetic recording device according to claim 20, wherein the projection end of the guide arm is located closer to the inner side of the head arm than the end of the head arm while maintaining a difference in altitude, and the rail part and the support part are formed to maintain the same difference in altitude as the above difference.

23. A card-type magnetic recording device according to claim 17, wherein a part of the opposite edges of the head arm in a longitudinal direction are bent in the shape of letter U in section, and a lead wire is housed in the bent portion.

24. A card-type magnetic recording device according to claim 17, wherein the head arm has a support spring whose end is formed in the shape of a gimbal part, the head is carried on the gimbal part, and the end of the gimbal part is engaged with an engagement hole formed at the end of the head arm.